REMARKS:

Claims 1-37 are currently pending in the application.

Claims 1-37 stand rejected under 35 U.S.C. § 112, second paragraph.

Claims 1-6, 12-17, 23-28, and 34-37 stand rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 6,055,515 to Consentino *et al.* ("*Consentino*") in view of U.S. Patent No. 6,076,091 to Fohn et al. ("*Fohn*").

Claims 7-11, 18-22, and 29-33 stand rejected under 35 U.S.C. § 103(a) over *Consentino* in view of *Fohn* and in further view of U.S. Patent No. 6,789,091 B2 to Gogolak ("*Gogolak*").

The Applicant initially notes that there appears to be certain typographical errors in the citations provided by the Examiner. For example, the Examiner states "in view of John et al. (U.S. Patent No. 6,076,091)", however; U.S. Patent No. 6,076,091 is actually by Fohn et al. ("*Fohn*"). (12 June 2007 Office Action, Page 3). The Applicant has reviewed the Office Action with particularity and has interpreted the above to mean – in view of Fohn et al. (U.S. Patent No. 6,076,091), however, the Applicant respectfully requests clarification from the Examiner. As another example, the Examiner states "Fohn et al. (U.S. Patent No. 6,038,668)", however; as stated above, U.S. Patent No. 6,076,091 is actually by Fohn et al. ("*Fohn*"). (12 June 2007 Office Action, Page 6).). The Applicant has reviewed the Office Action with particularity and has interpreted the above to mean – Fohn et al. (U.S. Patent No. 6,076,091), however, the Applicant respectfully requests clarification from the Examiner.

Initially, the Applicant respectfully notes that *Gogolak*, which issued on 7 September 2004, was filed on 2 May 2001, with no claim of priority to an earlier date. The subject Application was filed on 28 June 2001. The Applicant believes, however, that the Applicant will be able to satisfy the requirements of 37 C.F.R § 131 by filing a declaration showing a completion of the present invention prior to 2 May 2001, and respectfully reserves Applicant's right to do so in the future during the pendency of the subject

Application. The Applicant also believes, however, that the present invention is not disclosed or fairly suggested by *Gogolak*, and therefore, transverses the rejection of Claims 7-11, 18-22, and 29-33 for the reasons recited below.

The Applicant respectfully submits that all of the Applicant's arguments and amendments are without *prejudice* or *disclaimer*. In addition, the Applicant has merely discussed example distinctions from the cited prior art. Other distinctions may exist, and as such, the Applicant reserves the right to discuss these additional distinctions in a future Response or on Appeal, if appropriate. The Applicant further respectfully submits that by not responding to additional statements made by the Examiner, the Applicant does not acquiesce to the Examiner's additional statements. The example distinctions discussed by the Applicant are considered sufficient to overcome the Examiner's rejections. In addition, the Applicant reserves the right to pursue broader claims in this Application or through a continuation patent application. No new matter has been added.

REJECTION UNDER 35 U.S.C. § 101:

The Applicant thanks the Examiner for withdrawing the rejection of Claims 1-37 under 35 U.S.C. § 101.

REJECTION UNDER 35 U.S.C. § 112:

Claims 1-37 stand rejected under 35 U.S.C. § 112 , second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. The Applicant respectfully disagrees.

Specifically the Examiner asserts that "it is unclear what is it [sic] meant by 'an automatic comparison'". (12 June 2007 Office Action, Page 3). The Applicant respectfully disagrees. Nonetheless, the Applicant has amended Claims 1, 12, 23, and 34-37 in an effort to expedite prosecution of this Application and to more particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. By making these amendments, the Applicants do not indicate agreement with or acquiescence to the

Examiner's position with respect to the rejections of these claims under 35 U.S.C. § 112, as set forth in the Office Action.

The Applicant respectfully submits that Claims 1-37 are considered to be in full compliance with the requirements of 35 U.S.C. § 112. The Applicant further respectfully submits that Claims 1-37 are in condition for allowance. Thus, the Applicant respectfully requests that the rejection of Claims 1-37 under 35 U.S.C. § 112 be reconsidered and that Claims 1-37 be allowed.

REJECTION UNDER 35 U.S.C. § 103(a):

Claims 1-6, 12-17, 23-28, and 34-37 stand rejected under 35 U.S.C. § 103(a) over *Consentino* in view of *Fohn.* Claims 7-11, 18-22, and 29-33 stand rejected under 35 U.S.C. § 103(a) over *Consentino* in view of *Fohn* and in further view of *Gogolak*.

The Applicant respectfully submits that the ***amendments to independent Claims 1, 12, 23, and 34-37 have rendered moot the Examiner's rejection of these claims and the Examiner's arguments in support of the rejection of these claims***. The Applicants further respectfully submit that amended independent Claims 1, 12, 23, and 34-37 in their current amended form contain unique and novel limitations that are not taught, suggested, or even hinted at in *Consentino*, *Fohn*, and *Gogolak*, either individually or in combination. Thus, the Applicant respectfully traverses the Examiner's obvious rejection of Claims 1-37 under 35 U.S.C. § 103(a) over the proposed combination of *Consentino*, *Fohn*, and *Gogolak*, either individually or in combination.

The Proposed *Consentino-Fohn* Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicant's Claims 1-6, 12-17, 23-28, and 34-37

For example, with respect to amended independent Claim 1, this claim recites:

> A computer-implemented ***system for categorizing product data in an electronic commerce transaction***, the system comprising ***a data association module operable to***:
>
> ***access a first product classification schema***, the first schema comprising a taxonomy comprising a hierarchy of classes for categorizing

one or more products, the first schema further comprising ontologies associated with one or more of the classes, each ontology comprising one or more product attributes, ***wherein each of the one or more products is associated with a global unique identifier***;

access target data to be associated with the first schema, the target data organized according to a second product classification schema;

determine one or more classes of the first schema with which at least a portion of the target data is associated based on a comparison between ***the target data and the product attributes*** of the ontologies of the first schema or between ***the target data and values for one or more of the product attributes*** of the ontologies of the first schema;

associate the at least a portion of the target data with one or more classes of the first schema in response to determining, based on the automatic comparison, ***the one or more classes of the first schema*** with which the at least a portion of the target data is associated; and

store the values for one or more of the product attributes of the ontologies of the first schema with which the target data is compared in one or more seller databases. (Emphasis Added).

In addition, *Consentino* or *Fohn* fail to disclose each and every limitation of amended independent Claims 12, 23, and 34-37.

The Applicant respectfully submits that *Consentino* fails to disclose, teach, or suggest amended independent Claim 1 limitations regarding a "computer-implemented ***system for categorizing product data in an electronic commerce transaction***" and in particular *Consentino* fails to disclose, teach, or suggest amended independent Claim 1 limitations regarding "***determine[ing] one or more classes of the first schema with which at least a portion of the target data is associated based on a comparison*** between ***the target data and the product attributes*** of the ontologies of the first schema or between ***the target data and values for one or more of the product attributes*** of the ontologies of the first schema". In particular, the Examiner equates "***determine[ing] one or more classes of the first schema with which at least a portion of the target data is associated based on a comparison***" recited in amended independent Claim 1 with a user that must "***determine the product description by clicking on the node***" disclosed in *Consentino*. (12 June 2007 Office Action, Page 4). (Emphasis Added).

However, "***clicking on the node*** ***disclosed in Consentino*** merely allows a user to determine the product description and to look at its parameters, and ***does not include, involve, or even relate to*** "***determine[ing] one or more classes of the first schema with which at least a portion of the target data is associated based on a comparison", as recited in amended independent Claim 1***. (Column 6, Lines 42-48). In contrast, "***determine[ing] one or more classes of the first schema with which at least a portion of the target data is associated based on a comparison***" recited in amended independent Claim 1 provides for a "***comparison*** between ***the target data and the product attributes*** of the ontologies of the first schema or between ***the target data and values for one or more of the product attributes*** of the ontologies of the first schema". Thus, the Applicant respectfully submits that the equations forming the foundation of the Examiner's comparison between *Consentino* and amended independent Claim 1 cannot be made. The Applicant further respectfully submits that these distinctions alone are sufficient to patentably distinguish amended independent Claim 1 from *Consentino*.

The Office Action Acknowledges that *Consentino* Fails to Disclose Various Limitations Recited in Applicant's Claims 1-6, 12-17, 23-28, and 34-37

The Applicant respectfully submits that the Office Action acknowledges, and the Applicant agrees, that *Consentino* fails to disclose the emphasized limitations noted above in amended independent Claim 1. Specifically the Examiner acknowledges that *Consentino* fails to "provide detail explanation for categorizing product data in an electronic commerce transaction." (12 June 2007 Office Action, Page 5). However, the Examiner asserts that the cited portions of *Fohn* disclose the acknowledged shortcomings in *Consentino*. The Applicant respectfully traverses the Examiner's assertions regarding the subject matter disclosed in *Fohn*.

The Applicant respectfully submits that *Fohn* fails to disclose, teach, or suggest amended independent Claim 1 limitations regarding a "computer-implemented ***system for categorizing product data in an electronic commerce transaction***". For example, the "***system for categorizing product data***" recited in amended independent Claim 1

provides for a "***data association module***" wherein the ***data association module*** is operable to "access a first product classification schema", "access target data to be associated with the first schema", "determine one or more classes of the first schema with which at least a portion of the target data is associated based on a comparison", "associate the at least a portion of the target data with one or more classes of the first schema in response to determining", and "store the values [...] in one or more seller databases". Thus, the Applicant respectfully submits that the equations forming the foundation of the Examiner's comparison between *Fohn* and amended independent Claim 1 cannot be made. The Applicant further respectfully submits that these distinctions alone are sufficient to patentably distinguish amended independent Claim 1 from *Fohn*.

The Office Action Fails to Properly Establish a *Prima Facie* case of Obvious over the Proposed *Consentino-Fohn* Combination

The Applicant respectfully submits that the Office Action fails to properly establish a *prima facie* case of obviousness based on the proposed combination of *Consentino* or *Fohn*, either individually or in combination. The Office Action has not shown the required teaching, suggestion, or motivation in these references or in knowledge generally available to those of ordinary skill in the art at the time of the invention to combine these references as proposed. The Office Action merely states that "it would have been obvious for an ordinary skilled person in the art at the time the invention was made to ***apply the [...] product cataloging technique as taught by Fohn into Consentino's system***". (12 June 2007 Office Action, Page 5). (Emphasis Added). The Applicant respectfully disagrees.

The Applicant further respectfully submits that this purported advantage relied on by the Examiner is nowhere disclosed, taught, or suggested in *Consentino* or *Fohn*, either individually or in combination. The Examiner asserts that the motivation to combine the references as proposed would be "because by doing so, [...] the combined invention will not only be upgraded for providing a multi-path hierarchical product cataloging system to allow a user performing interactive e-commerce transactions, but will also be integrated with the data consumed by the user back into the system for facilitating the product

cataloging design via the generic portal technique". (12 June 2007 Office Action, Page 5). The Applicant respectfully submits that the same argument was stated in the previous Office Action in support of motivation to combine *Consentino* and *Chipman*. In light of this and in light of the fact that the Examiner has not supported this motivation to combine in the prior art of record, the ***Applicant respectfully requests the Examiner to point to the portions of Consentino* or *Fohn which contain the teaching, suggestion, or motivation to combine these references for the Examiner's stated purported advantage***. The Applicant further respectfully submits that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the ***prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art***. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). (Emphasis Added). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id*. at 1434-35. With respect to the subject Application, the ***Examiner has not adequately supported the selection and combination of Consentino* or *Fohn to render obvious the Applicant's claimed invention***. The Examiner's unsupported conclusory statements that "it would have been obvious for an ordinary skilled person in the art at the time the invention was made to ***apply the [...] product cataloging technique as taught by Fohn into Consentino's system***" and "because by doing so, [...] the combined invention will not only be upgraded for providing a multi-path hierarchical product cataloging system to allow a user performing interactive e-commerce transactions, but will also be integrated with the data consumed by the user back into the system for facilitating the product cataloging design via the generic portal technique", ***does not adequately address the issue of motivation to combine***. (12 June 2007 Office Action, Page 5). This factual question of motivation is material to patentability, and cannot be resolved on subjective belief and unknown authority. *Id*. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983). Thus, ***the Office***

Action fails to provide proper motivation for combining the teachings of Consentino* or *Fohn, either individually or in combination.

The Applicant's Claims are Patentable over the proposed *Consentino-Fohn* Combination

The Applicant respectfully submits that amended independent Claim 1 is considered patentably distinguishable over the proposed combination of *Consentino* and *Fohn*. This being the case, amended independent Claims 12, 23, and 34-37 are also considered patentably distinguishable over the proposed combination of *Consentino* and *Fohn*, for at least the reasons discussed above in connection with amended independent Claim 1.

Furthermore, with respect to dependent Claims 2-6, 13-17, and 24-28: Claims 2-6 depend from amended independent Claim 1; Claims 13-17 depend from amended independent Claim 12; and Claims 24-28 depend from amended independent Claim 23. Thus, dependent Claims 2-6, 13-17, and 24-28 are considered patentably distinguishable over *Consentino* and are also considered to be in condition for allowance for at least the reason of depending from an allowable claim.

Thus, for at least the reasons set forth herein, the Applicant respectfully submits that independent Claims 1, 12, 23, and 34-37 and dependent Claims 2-6, 13-17, and 24-28 are not anticipated by *Consentino*. The Applicant further respectfully submits that independent Claims 1, 12, 23, and 34-37 and dependent Claims 2-6, 13-17, and 24-28 are in condition for allowance. Thus, the Applicant respectfully requests that the rejection of Claims 1-6, 12-17, 23-28, and 34-37 under 35 U.S.C. § 103(a) be reconsidered and that Claims 1-6, 12-17, 23-28, and 34-37 be allowed.

The Proposed *Consentino-Fohn-Gogolak* Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicant's Dependent Claims 7-11, 18-22, and 29-33

As discussed above, the Applicant respectfully reserves the right to satisfy the requirements of 37 C.F.R § 131 by filing a declaration showing a completion of the present

invention prior to 2 May 2001, in the future during the pendency of the subject Application. However, the Applicant believes that the present invention is not disclosed or fairly suggested by *Gogolak*, and therefore, transverses the rejection of Claims 7-11, 18-22, and 29-33 for the reasons recited below.

The Office Action Acknowledges that the *Consentino-Fohn* Combination Fails to Disclose Various Limitations Recited in Applicant's Claims 7-11, 18-22, and 29-33

The Applicant respectfully submits that the Office Action acknowledges, and the Applicant agrees, that the combination of *Consentino* and *Fohn* fail to disclose the limitations in dependent Claims 7-11, 18-22, and 29-33. (12 June 2007 Office Action, Page 6).

Specifically, the Examiner acknowledges that *Consentino* and *Fohn* do not expressly disclose a "***data association module operable to***" "***us[e] vector space analysis to identify multiple portions of the target data*** including values that correspond to values for multiple product attributes included in the ontologies of these one or more classes of the first schema", "***us[e] statistical correlation techniques to identify portions of the target data*** including values that correspond to values for a product attribute included in the ontologies of these one or more classes of the first schema", "***the values in the seller databases being identified by one or more pointers associated with one or more classes of the first schema***", "***associat[e] one or more pointers to the target data with the one or more classes of the first schema***", and "***associat[e] one or more pointers to specific portions of the target data with one or more product attributes included in the ontology of the one or more classes of the first schema***", as recited in dependent Claims 7-11, 18-22, and 29-33. (Emphasis Added). However, the Examiner asserts that the cited portions of *Gogolak* disclose the acknowledged shortcomings in *Consentino* and *Fohn*. The Applicant respectfully traverses the Examiner's assertions regarding the subject matter disclosed in *Gogolak*.

The Applicant respectfully submits that the proposed *Consentino*, *Fohn*, and *Gogolak* combination fails to disclose, teach, or suggest various limitations recited in

Applicant's dependent Claims 7, 8, 18, 19, 29, and 30. For example, with respect to dependent Claims 7 and 8, these claims recite:

> 7. The system of Claim 1, wherein determining one or more classes of the first schema with which the at least a portion of the target data is associated comprises ***using vector space analysis to identify multiple portions of the target data*** including values that correspond to values for multiple product attributes included in the ontologies of these one or more classes of the first schema. (Emphasis Added).
>
> 8. The system of Claim 1, wherein determining one or more classes of the first schema with which the at least a portion of the target data is associated comprises ***using statistical correlation techniques to identify portions of the target data*** including values that correspond to values for a product attribute included in the ontologies of these one or more classes of the first schema. (Emphasis Added).

In addition, *Consentino*, *Fohn*, and *Gogolak*, either individually or in combination, fail to disclose each and every limitation of dependent Claims 18, 19, 29, and 30.

The Applicant respectfully submits that *Gogolak* fails to disclose, teach, or suggest dependent Claims 7 and 8 limitations regarding a "computer-implemented ***system for categorizing product data in an electronic commerce transaction***, the system comprising ***a data association module***" operable to "***determine one or more classes of the first schema with which at least a portion of the target data is associated***" and in particular *Gogolak* fails to disclose, teach, or suggest dependent Claims 7 and 8 limitations regarding "using vector space analysis to identify multiple portions of the target data including values that correspond to values for multiple product attributes included in the ontologies of these one or more classes of the first schema" and "using statistical correlation techniques to identify portions of the target data including values that correspond to values for a product attribute included in the ontologies of these one or more classes of the first schema".

Rather *Gogolak* discloses a "method for accessing and analyzing the adverse effects resulting from the use of at least one drug of interest." (Abstract). It appears that the Examiner is equating using "vector space analysis" and "statistical correlation techniques" recited in dependent Claims 7 and 8 with the "Query Screen" disclosed in

Gogolak. (12 June 2007 Office Action, Page 7). However, the "Query Screen" disclosed in *Gogolak* merely provides for a search in which a user can choose to search via a generic name, a trade name or a category, ***and does not include or is not even related to*** using "vector space analysis" or "statistical correlation techniques" as recited in dependent Claims 7 and 8. (Column 15, Lines 54-65). In contrast, using "vector space analysis" and "statistical correlation techniques" recited in dependent Claims 7 and 8 is provided to "identify multiple [or singular] portions of the target data including values that correspond to values for multiple [or singular] product attributes included in the ontologies of these one or more classes of the first schema." Thus, the Applicant respectfully submits that the equations forming the foundation of the Examiner's comparison between *Gogolak* and dependent Claims 7 and 8 cannot be made. The Applicant further respectfully submits that these distinctions alone are sufficient to patentably distinguish dependent Claims 7 and 8 from *Consentino*, *Fohn*, and *Gogolak*.

The Applicant further respectfully submits that the proposed *Consentino*, *Fohn*, and *Gogolak* combination fails to disclose, teach, or suggest various limitations recited in Applicant's dependent Claims 9, 20, and 31. For example, with respect to dependent Claim 9, this claim recites:

> 9. The system of Claim 1, wherein ***the values in the seller databases being identified by one or more pointers associated with one or more classes of the first schema***. (Emphasis Added).

In addition, *Consentino*, *Fohn*, and *Gogolak*, either individually or in combination, fail to disclose each and every limitation of dependent Claims 20 and 31.

The Applicant respectfully submits that *Gogolak* fails to disclose, teach, or suggest dependent Claim 9 limitations regarding "stor[ing] the values for one or more of the product attributes of the ontologies of the first schema with which the target data is compared in the one or more seller databases" and in particular *Gogolak* fails to disclose, teach, or suggest dependent Claim 9 limitations regarding "***the values in the seller databases being identified by one or more pointers associated with one or more classes of the first schema***." (Emphasis Added).

It appears that the Examiner is equating the "***values in the seller databases***" recited in dependent Claim 9 with the "structural database" disclosed in *Gogolak*. (12 June 2007 Office Action, Page 7). However, the "structural database" disclosed in *Gogolak* merely provides an ability to keep a consistent vocabulary and data regarding adverse drug reactions, ***and does not include or is not even related to*** the "***values in the seller databases***", as recited in dependent Claim 9. (Column 21, Lines 23-56). In contrast, the "***values in the seller databases***" recited in dependent Claim 9 are "***identified by one or more pointers associated with one or more classes of the first schema***". Thus, the Applicant respectfully submits that the equations forming the foundation of the Examiner's comparison between *Gogolak* and dependent Claim 9 cannot be made. The Applicant further respectfully submits that these distinctions alone are sufficient to patentably distinguish dependent Claim 9 from *Consentino*, *Fohn*, and *Gogolak*.

The Applicant still further respectfully submits that the proposed *Consentino*, *Fohn*, and *Gogolak* combination fails to disclose, teach, or suggest various limitations recited in Applicant's dependent Claims 10, 11, 21, 22, 32, and 33. For example, with respect to dependent Claims 10 and 11, these claims recite:

> 10. The system of Claim 1, wherein associating the at least a portion of the target data with one or more classes of the first schema comprises ***associating one or more pointers to the target data with the one or more classes of the first schema***. (Emphasis Added).
>
> 11. The system of Claim 1, wherein associating the at least a portion of the target data with one or more classes of the first schema comprises ***associating one or more pointers to specific portions of the target data with one or more product attributes included in the ontology of the one or more classes of the first schema***. (Emphasis Added).

In addition, *Consentino*, *Fohn*, and *Gogolak*, either individually or in combination, fail to disclose each and every limitation of dependent Claims 21, 22, 32, and 33.

The Applicant respectfully submits that *Gogolak* fails to disclose, teach, or suggest dependent Claims 10 and 11 limitations regarding a "computer-implemented ***system for categorizing product data in an electronic commerce transaction***, the system

comprising ***a data association module***" operable to "***associate the at least a portion of the target data with one or more classes of the first schema in response to determining***, based on the automatic comparison, ***the one or more classes of the first schema*** with which the at least a portion of the target data is associated" and in particular *Gogolak* fails to disclose, teach, or suggest dependent Claims 10 and 11 limitations regarding "***associating one or more pointers to the target data with the one or more classes of the first schema***" and "***associating one or more pointers to specific portions of the target data with one or more product attributes included in the ontology of the one or more classes of the first schema***".

It appears that the Examiner is equating "***associating one or more pointers***" recited in dependent Claims 10 and 11 with the "correlated search" disclosed in *Gogolak*. (12 June 2007 Office Action, Page 7). However, the "correlated search" disclosed in *Gogolak* merely looks for the association of characteristics of drug information, ***and does not include or is not even related to*** "***associating one or more pointers***", as recited in dependent Claims 10 and 11. (Column 21, Lines 23-56). In contrast, "***associating one or more pointers***" recited in dependent Claims 10 and 11 is provided for "***associating one or more pointers to specific portions of the target data with one or more product attributes included in the ontology of the one or more classes of the first schema***". Thus, the Applicant respectfully submits that the equations forming the foundation of the Examiner's comparison between *Gogolak* and dependent Claims 10 and 11 cannot be made. The Applicant further respectfully submits that these distinctions alone are sufficient to patentably distinguish dependent Claims 10 and 11 from *Consentino*, *Fohn*, and *Gogolak*.

The Office Action Fails to Properly Establish a *Prima Facie* case of Obvious over the Proposed *Consentino-Fohn-Gogolak* Combination

The Applicant respectfully submits that the Office Action has failed to properly establish a *prima facie* case of obviousness based on the proposed combination of *Consentino*, *Fohn*, or *Gogolak*, either individually or in combination. The Office Action has not shown the required teaching, suggestion, or motivation in these references or in

knowledge generally available to those of ordinary skill in the art at the time of the invention to combine these references as proposed. The Office Action merely states that "it would have been obvious for an ordinary skilled person in the art at the time the invention was made to apply ***the well-known technique*** into the combined system of *Consentino* and *Fohn* for determining the associations of these attribute-value pairs with the weight calculation to indexing the read/write processing as taught by *Gogolak*". (12 June 2007 Office Action, Page 7). The Applicant respectfully disagrees.

The Applicant further respectfully submits that this purported advantage relied on by the Examiner is nowhere disclosed, taught, or suggested in *Consentino*, *Fohn*, or *Gogolak*, either individually or in combination. The Examiner asserts that the motivation to combine the references as proposed would be because "***the surrounding background noise data will be filtered out based on a use desire***." (12 June 2007 Office Action, Page 7). (Emphasis Added). The Applicant respectfully disagrees and further respectfully requests clarification as to how the Examiner arrives at this conclusion. For example, what is "***the well-known technique*** [...] for determining the associations of these attribute-value pairs" and how does the Examiner arrive at the conclusion that this is a "***well-known technique***" and to what extent does the Examiner purport that this "***well-known technique***" applies to the subject Application. As another example, what is a "***use desire***" and to what extent does the Examiner purport that this "***use desire***" even applies to the subject Application. ***The Applicant respectfully requests the Examiner to point to the portions of Consentino, Fohn,*** **or** ***Gogolak which contain the teaching, suggestion, or motivation to combine these references for the for the Examiner's stated purported advantage***. In particular, the Applicant respectfully requests the Examiner to point to the portions of *Consentino*, *Fohn*, or *Gogolak* which expressly state what "***the well-known technique***" is and what a "***use desire***" is and how these apply to the subject Application. The Applicant further submits that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the ***prior art must disclose each and every element of the claimed***

invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). (Emphasis Added). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id*. at 1434-35. With respect to the subject Application, the ***Examiner has not adequately supported the selection and combination of Consentino, Fohn, or Gogolak to render obvious the Applicant's claimed invention***. The Examiner's unsupported conclusory statements that "it would have been obvious for an ordinary skilled person in the art at the time the invention was made to apply ***the well-known technique*** into the combined system of *Consentino* and *Fohn* for determining the associations of these attribute-value pairs with the weight calculation to indexing the read/write processing as taught by *Gogolak*" and because "***the surrounding background noise data will be filtered out based on a use desire***", ***does not adequately address the issue of motivation to combine***. (12 June 2007 Office Action, Page 7). (Emphasis Added). This factual question of motivation is material to patentability, and cannot be resolved on subjective belief and unknown authority. *Id*. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983). Thus, ***the Office Action fails to provide proper motivation for combining the teachings of Consentino, Fohn, or Gogolak***, either individually or in combination.

The Applicant's Claims are Patentable over the Proposed *Consentino-Fohn-Gogolak* Combination

The Applicant respectfully submits that amended independent Claims 1, 12, 23, and 34-37 are considered patentably distinguishable over the proposed combination of *Consentino*, *Fohn*, and *Gogolak*. This being the case, amended independent Claims 1, 12, 23, and 34-37 are considered to be in condition for allowance.

With respect to dependent Claims 7-11, 18-22, and 29-33: Claims 7-11 depend from amended independent Claim 1; Claims 18-22 depend from amended independent Claim 12; and Claims 29-33 depend from amended independent Claim 23. As mentioned

above, each of amended independent Claims 1, 12, 23, and 34-37 are considered patentably distinguishable over *Consentino*, *Fohn*, and *Gogolak*. This being the case, dependent Claims 7-11, 18-22, and 29-33 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

For at least the reasons set forth herein, the Applicant respectfully submits that Claims 7-11, 18-22, and 29-33 are not rendered obvious by the proposed combination of *Consentino*, *Fohn*, and *Gogolak*. The Applicant further respectfully submits that Claims 7-11, 18-22, and 29-33 are in condition for allowance. Thus, the Applicant respectfully requests that the rejection of Claims 7-11, 18-22, and 29-33 under 35 U.S.C. § 103(a) be reconsidered and that Claims 7-11, 18-22, and 29-33 be allowed.

THE LEGAL STANDARD FOR OBVIOUSNESS REJECTIONS UNDER 35 U.S.C. § 103:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, ***there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings***. Second, there must be a reasonable expectation of success. Finally, ***the prior art reference*** (or references when combined) ***must teach or suggest all the claim limitations***. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, ***and not based on applicant's disclosure***. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. Moreover, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

With respect to alleged obviousness, ***there must be something in the prior art as a whole to suggest the desirability***, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination.

Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The consistent criterion for determining obviousness is whether the prior art would have suggested to one of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991; *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.

A recent Federal Circuit case makes it clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id*. at 1434-35.

CONCLUSION:

In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

Although the Applicant believes no fees are deemed to be necessary; the undersigned hereby authorizes the Commissioner to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777**. If an extension of time is necessary for allowing this Response to be timely filed, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) to the extent necessary. Any fee required for such Petition for Extension of Time should be charged to **Deposit Account No. 500777**.

Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.

Respectfully submitted,

12 September 2007
Date

/Steven J. Laureanti/signed
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